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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,710	07/02/2004	Shane P Rossiter	CPG 02-03 MD	2430
38235 7590 09/04/2007 MEADWESTVACO CORPORATION ALEXANDRA B. URBAN,ESQ. 299 PARK AVENUE, 13TH FLOOR NEW YORK, NY 10171			EXAMINER PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	
			MAIL DATE	DELIVERY MODE
			09/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/500,710	ROSSITER, SHANE P	
	Examiner	Art Unit	
	Greg Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 15-20 and 26-40 is/are allowed.
- 6) ☒ Claim(s) 6-14, 21 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment of 22 June 2007 is acknowledged. Claims 1-40 are pending in the application.

It is noted that the amendment is not fully compliant with 37 CFR 1.121 in that claim 8 is provided with the "Original" status identifier, yet clearly shows changes to the claim. To expedite prosecution of the application, it is presumed that the correct status identifier for claim 8 is "Currently Amended".

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. In light of the applicant's amendment, the rejections under 35 U.S.C. 112, 2nd paragraph, are withdrawn.

Claim Rejections - 35 USC § 102

4. Claims 10-14, 21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosterka (US 4,709,812).

Claim 10: It is noted that trays are not required on all of the boards, only a plurality. Accordingly, Kosterka discloses a boxed disc package comprising a box (carton in Figure 8), a foldable, rigid creased board (**50**, see Figure 1) having multiple parallel creases **61, 62, 63, & 64** forming alternating board receiving panels **52, 54, &**

Art Unit: 3728

56 and spines **57 & 59**, and disc holding trays **41** mounted on the panels (see for example Figure 6). Kosterka rotates the folded assembly 90 deg. such that the spines are positioned along opposite sidewalls of the box; therefore, one of the spines is "mounted along" a side of the box.

Claims 11-13: Kosterka discloses first end panel **52**, second end panel **56**, intermediate panel **54**, first end spine **57**, and second end spine **59** arranged as claimed.

Claim 14: The spines of Kosterka are of lengths as claimed.

Claim 21: It is noted that trays are not required on all of the boards, only a plurality. Accordingly, Kosterka discloses a boxed disc package comprising a box (carton in Figure 8), a foldable carrier (**50**, see Figure 1) having multiple parallel creases **61, 62, 63, & 64** forming alternating board receiving panels **52, 54, & 56** and spines **57 & 59**, and disc holding trays **41** mounted on the panels (see for example Figure 6). One section of the foldable carrier is secured to a bottom of the box base upon closure of the carton.

Claim 23: Kosterka rotates the folded assembly 90 deg. such that the spines are positioned along opposite sidewalls of the box.

Claim 24: Kosterka discloses the panels on the board folded as claimed. It is noted that "hinged near" does not imply --attached to--.

Claim 25: Kosterka discloses the panels on the board folded as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosterka (US 4,709,812) in view of Gelardi et al (US 5,884,761).

Claim 6: Kosterka discloses a boxed disc package comprising a box base (bottom of carton in Figure 8), a foldable, rigid creased board (50, see Figure 1) having multiple parallel creases 61, 62, 63, & 64, plural board receiving panels 52, 54, & 56, plural spines 57 & 59, plural tray holding boards 51, 53, & 55, and plural disc holding trays 41 (see for example Figure 6). One of the board receiving panels is "placed in" a bottom of the box base. Kosterka merely lacks the disc holding trays on each board-receiving panel.

In Figure 22, Gelardi shows that placement of disc-receiving trays on each panel of a tri-folding arrangement was known and desirable in the art. Forming the panels of Kosterka with trays on each panel is considered a mere duplication of the existing parts since each element performs the same function with no unexpected results. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the assembly of Kosterka with trays on each panel as claimed; such a modification would predictably retain a larger number of discs. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 1727, 82 USPQ2d 1385 (2007).

Claim 7: Kosterka rotates the folded assembly 90 deg. such that the spines are positioned along opposite sidewalls of the box.

Claim 8: Kosterka discloses one of the boards mounted on an inwardly facing side.

Claim 9: Kosterka discloses the panels on the board folded as claimed.

Allowable Subject Matter

6. Claims 1-5, 15-20 and 26-40 appear to define over the available prior art.

7. Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

9. Applicant's arguments filed 22 June 2007 have been fully considered but they are not persuasive.

Claims 10 and 21, although reciting the trays and boards in the plural form, do not require trays on each board. In accordance with MPEP 2111.01, during examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). Kosterka discloses plural trays on plural panels, the fact that Kosterka discloses an additional panel in between the tray-holding panels is immaterial since the applicant uses the open terminology, "comprising".

The arguments concerning claims 6-9 have been fully considered, but are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Pickett/
Examiner
Art Unit 3728